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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,111	03/02/2004	Norihiko Tanaka	FY.51034US1A	2453
20995	7590	03/23/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			SHRIVER II, JAMES A	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			3618	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/791,111

Applicant(s)

TANAKA ET AL.

Examiner

J. Allen Shriver

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 11-19 is/are rejected.
- 7) ☒ Claim(s) 7-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/2/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. Claim 6 is objected to because of the following informalities: In claim 6, line 3, the phrase “plane that passes extends along the top end” is unclear. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1, 5-6, 11, 13 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Korenjak et al. (US Patent 6,896,087 B2).** Korenjak et al. discloses an off-road vehicle (16) comprising a frame (17), at least one front wheel (18) and at least one rear wheel (20), the front and rear wheels supporting the frame, a seat (See Fig. 2) disposed on the frame, an internal combustion engine (10) being mounted to the frame, the engine comprising a crankshaft (12), a transmission (26) comprising an output shaft (324), the output shaft being connected to the crankshaft (See Figs. 20-21), the output shaft driving at least one of the front wheel and the rear wheel, the seat having a front end and a rear end, the crankshaft being positioned between the output shaft and the rear wheel (See Figs. 2-3), an at least the output shaft being disposed

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between a generally vertically extending first plane that extends through the front end of the seat and a generally vertically extending second plane that extends through the rear end of the seat (See Fig. 2); **[claim 5]** wherein the engine comprises an air intake system and an exhaust system and the air intake system and the exhaust system extend in opposite directions from the engine (See column 5, line 65+); **[claim 6]** wherein the seat has a top end and at least one of the crankshaft and the output shaft is positioned vertically lower than a generally horizontally extending third plane that passes along the top end of the seat (See Fig. 2); **[claim 11]** wherein the engine and the transmission are directly connected with casings such that a unitarily construction results; **[claim 13]** wherein a pair of front wheels and a pair of rear wheels support the frame.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 2-4, 14-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Korenjak et al. (US Patent 6,896,087 B2).** Korenjak et al. discloses an off-road vehicle as set forth above, but does not disclose wherein at least a portion of the engine also extends through the second plane. Korenjak et al. shows the location of the seat in Figure 2 only in dashed lines. The court has held that the configuration of a device was a matter of choice, which a person of ordinary skill in the art would have found obvious absent persuasive evidence that

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the particular configuration of the claimed device was significant. See *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). In this case, the size and configuration of the seat disclosed in Korenjak et al. could easily be configured to allow at least a portion of the engine to extend through the second plane of the seat. The motivation for reconfiguring the seat would be to shorten the length of the seat to provide a storage compartment behind the seat to store items.

Regarding claims 3-4, Korenjak et al. does not disclose wherein the air intake system extends generally forward from the front surface of the engine and the exhaust system generally extends rearward from the rear surface of the engine. Korenjak et al. discloses the exhaust system extending to the front and the air intake extending to the rear of the engine. In column 5, line 65+ to column 6 line 5, Korenjak et al. discloses wherein the orientation of the engine could be reversed so that the air intake system would generally extend forward from the front surface of the engine, without deviating from the scope of the invention.

Regarding claim 15, Korenjak et al. discloses wherein the seat has a bottom end upon which an occupant sits and the crankshaft is positioned vertically lower than a generally horizontally extending third plane that extends along the bottom end of the seat.

Regarding claims 16 and 18, Korenjak et al. discloses in Figure 2, wherein at least a portion of the engine being vertically higher than a generally horizontally extending third plane that extends along the bottom end of the seat.

**6. Claims 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Korenjak et al. (US Patent 6,896,087 B2) in view of Furuhashi et al. (US Patent 5,327,989).** Korenjak et al. discloses an off-road vehicle as set forth above, but does not disclose wherein at least a portion of the engine is positioned rearward of a back rest associated with the seat.

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Furuhashi et al. discloses providing a back rest for the seat (See Fig. 1). At the time of the invention, it would have been obvious to a person of ordinary skill in this art to provide a back rest for the seat disclosed in Korenjak et al. in view of the teaching of Furuhashi et al. The motivation for doing so would have been to allow the rider to sit in a more upright position, with their back supported.

*Allowable Subject Matter*

7. Claims 7-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

8. The prior art made of record in the accompanying PTO Form 892 and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Allen Shriver whose telephone number is (571) 272-6698. The examiner can normally be reached on Monday, Wednesday and Thursday 6:30 am-6:00 pm and Tuesday 6:30 am-11:00 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris P. Ellis can be reached on (571) 272-6914. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-1113.

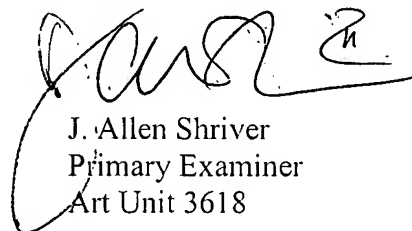
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As of May 1, 2003, any response to this action should be mailed to:

Mail Stop \_\_\_\_\_  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or faxed to: (571) 273-8300 (for formal communications intended for entry). (571) 273-6698 (for informal communications directly to the Examiner).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. Allen Shriver  
Primary Examiner  
Art Unit 3618

JAS